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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/891,261	07/10/97	DORF R	012585-1

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EXAMINER
FELTEN, D

ART UNIT	PAPER NUMBER
2876	6

DATE MAILED: 01/28/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/891,261

Applicant(s)  
Dorf

Examiner  
Daniel Felten

Group Art Unit  
2876



☒ Responsive to communication(s) filed on Sep 29, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-66 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-66 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2, 3, & 5

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Bertina et al (US 5,682,027).

Bertina et al discloses a multifunction card system comprising;

- a. at least one debit/medical services card having a unique identification number encoded on it;
- b. a transaction processor 11 receiving card data from an existing standard point-of-sale device, said card data including a unique identification number;
- c. a processing hub 27 receiving directly or indirectly said card data 14 from said transaction processor; and

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d. said processing hub 27 accessing a first database when the card functions as a debit card and said processing hub accessing a second database when the card functions as a medical card (see figure 2, column 16, lines 50-55).

A multifunction card system wherein the unique identification number is a medical identification number (column 15, lines 5-14).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-31, and 34-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bertina et al (US 5,682,027).

Bertina et al discloses a multifunction card system 13 having a unique identification number encoded on the card comprising a bank identification number corresponding to the multifunction card system (see column 7, lines 6-9).

means for receiving card activation data from an existing device when card is swiped through a standard retail point-of-sale (POS) device 11, activation data comprising a unique

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identification number of the card and the activation amount (see figure 2, column 5, lines 49-65);  
and

having a processing hub 27 to transmit data to and receive from the card (see figure 2).

Although Bertina et al fails to explicitly disclose in the above embodiment, a card functioning as a electronic gift certificate, a prepaid phone card system, and a loyalty card system all at the same time, he makes a list of applications (e.g. Banking transaction, Bill payment, Drug prescription, Health benefit refunding, Medical history summary, etc., etc.) that could all be operated within one IC card, along with teaching that the transaction of the system revolves around the use of program modules 43 which can be programed for the specific purpose of the service provider and the service user, and are downloaded to the IC card for governing the particular transaction which is to take place after the transaction has initially been established (see figure 2, column 15, lines 25-65). It would therefore have been obvious to an artisan at the time of the invention to create a system with a card possessing all the features found in a electronic gift certificate, prepaid phone card and loyalty card because such a modification would obviously have been within the scope of the invention.

### ***Conclusion***

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1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Moreno (US 3,971,916) discloses methods of data storage and data storage systems. Benton et al (US 5,706,455) discloses a distributed database configuration with graphical representations having prelinked parameters for devices within a networked control system.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:30AM to 4:30PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Hajec, can be reached on (703) 308-7045. The fax phone number for this Group is (703)308-7382 or (703) 308-7722.


Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.felten@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1 195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DSF

January 4, 1999

  
Donald Hajec  
Supervisory Patent Examiner  
Technology Center 2800